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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/090,561

03/04/2002

Basil Naji

131279-1019

5549

60148 7590 11/01/2007  
GARDERE / JAMES HARDIE  
GARDERE WYNNE SEWELL, LLP  
1601 ELM STREET  
SUITE 3000  
DALLAS, TX 75201

EXAMINER

MARCANTONI, PAUL D

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

11/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/090,561

Applicant(s)

NAJI ET AL.

Examiner

Paul Marcantoni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12 and 16-24 is/are pending in the application.
- 4a) Of the above claim(s) 21-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12 and 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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Applicant's arguments filed 7/24/07 have been fully considered but they are not persuasive.

Non-Elected By Original Presentation:

Claims 21-24 are directed to inventions non-elected by original presentation. Accordingly, these claims have been withdrawn from consideration.

New Matter-Claims:

Claims 12 and 17-19 are rejected under 35 USC 112 first paragraph and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed.

Claims 12, 18, and 19 contain new matter. The terms "greater than 100 microns" is new matter in these or any other claims it is used. There is only original support for greater than about 100 microns. Applicants are referred to their own specification (paragraph [0038]) and original claim 12 which requires the use of the term "about" in this particle size limitation for the coarse fraction fly ash.

35 USC 112 Second Paragraph (withdrawn)

However, the examiner has interpreted "hydraulic binder based" to mean the same as "hydraulic binder containing".

Obviousness Type Double Patenting:

Claims 1-9 and 16-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,749,897 (Naji et al.) AND 10/090,385 (Naji et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach the

Claims 1-9,12, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 60191074 A (Matsushita abstract), Liskowitz (WO 97/21640 which is PCT/US96/19936), or Massey '944.

*Note: Francis et al. '518 has been withdrawn from the rejection.*

Explanation and analysis for JP '074 and Liskowitz can be found in preceding office actions. Applicants may refer back to them for further details.

Massey (US 4,441,944) teaches a building board composition comprising mixing Portland cement (hydraulic binder), fly ash, fibers, water, and other components in amounts overlapping applicants' claimed composition from mixing fly ash, hydraulic binder, and water (as well as fibers or other components). The applicants are referred to the claims for this teaching. It is further noted that, as was pointed out in Francis, Massey simply uses fly ash which typically and conventionally ranges from about 1 to 100 microns which is in the applicants' claimed ranges for small, large, and coarse (optional) fraction fly ash portions. Overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art.

Response to 7/24/07 Applicant Remarks:

The applicants did not amend their claims from the examiner's indication of new matter in claims 12, 18, and 19. They state that "greater than 100 microns" (the new matter limitation) falls within the scope of "greater than about 100 microns". In rebuttal, there is no literal support for this claimed limitation but only for "greater than about 100 microns". The new matter rejection stands.

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coating (whether actively or as an intended use) using the same components in overlapping amounts.

Note: The applicants did not alert examiner their own co-pending application 10/090,385 (Naji) which also teaches their claimed invention. Under the new rules effective Nov.1, 2007, it is permissible to make this application final over commonly owned applications which applicants were aware of.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### 35 USC 103:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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ODP Rejection:

Again, this is not a proper response to an ODP rejection to hold it in abeyance until indication of allowable subject matter. Applicants are reminded that they were supposed to traverse the rejection or send in a terminal disclaimer in this response. As they did not, any submission after this time can be considered untimely and entry of a terminal disclaimer thus denied.

Matsushita:

The applicants alleged new property or discover of fly ash as a "dewatering aid" is not new at all. See p.2 lines 13-14 of Liskowitz wherein he teaches that "incorporation of fly ash in concrete improves workability and thereby reduces the water requirement with respect to conventional concrete. If it reduces water requirement, fly ash is most certainly and commonly understood in the art as a dewatering aid. Thus, the addition of adding fly ash as a dewatering aid to a cement composition would have been old and conventional in the art.

Matsushita teaches the same components in a process of mixing cement, fly ash (in overlapping amounts) and water and still meets applicants' claims. The ratios of amounts of the larger particle size and smaller particle size fly ash (5/1 to 2/1) do overlap applicants' fly ash amounts of their own large size and small size fly ash. Matsushita teaches his reactive fillers for both large and small size can be also fly ash just as in applicants' claimed invention. A reference is good for all that it realistically teaches and one of ordinary skill in the art would have the capability to select fly ash for both large and small particle sizes for their reactive fillers.

The applicants' claims would also appear limited to only the method of making a coating by mixing cement, fly ash, and water and Matsushita does teach that. The applicants limitations "for coating a building board having a first and second surface" in the preamble is an intended use (e.g. see claim 1). The applicants limitation "such that after application of said formulation to said first surface of said building board, said slurry is dewatered through the building board to said second surface of said building board is also an intended use like the preamble. There is no active actual step of the method actually comprising a step of coating. The method is limited to mixing the ingredients to make the coating which can be later applied but the method itself being claimed is only a method of mixing the ingredients to make the coating.

The applicant also allege that Matsushita is non-enabling. The examiner disagrees as they also teach how to make a cement coating formulation comprising fly ash and water. The applicants allege that they provide a solution to a known problem by preparing a suitable coating for a building product with a surface finish. Their solution is also known since its old in the art to add fly ash to cement based (ie hydraulic binder) compositions for coating. The use of cement compositions (ie especially mortars) are notoriously known in the art for coating a surface and it would have been an obvious design choice for one of ordinary skill in the art to coat a surface or board with a known cement coating material.

The applicants argue Liskowitz particle size range versus their own particle size range.

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Yet, it should be noted that applicants have not shown any criticality or unexpected result for their specific range of particle sizes over the prior art. Liskowitz teaches that fly ash itself typically ranges in diameter from 1 to 150 microns (p.3, line 18). Thus, though the specific amounts for each particle size for specific amounts of small size or large size fly ash are not stated in Liskowitz, he teaches adding fly ash for construction purposes is known including mortars which are known coating materials. The applicants only state that fly ash itself functions as a dewatering agent yet that is also the situation for Liskowitz's fly ash since he too teaches the same function of fly ash; to reduce water requirement for cement/concrete (p.2, lines 13-14).

The applicants argue Liskowitz composition cannot be used to coat a building board and they allege its limited to commercial concrete and mortars. The examiner disagrees. Mortars are coatings and commonly used to coat construction substrates. Also, the specific ranges of amounts is the same for Liskowitz as other coating compositions used for coating building boards. Thus, the use of this composition for coating a building board would have been an available design choice for one of ordinary skill in the art.

The applicants appear to argue that because Massey teaches components not taught in their invention it thus teaches away from it. The examiner disagrees. Comprising leaves the claim open for the inclusion of unspecified ingredients even in major amounts. Ex parte Davis et al., 80 USPQ 448 (PTO Bd of App.1948). This also includes foamed styrene beads and latex which may or may not be part of applicants



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composition. Applicants "comprising" claim language thus does not exclude these components of Massey's composition.

The applicants argue size of fly ash alleging that this is critical since they claim a specific amount of a large particle size and small particle size. As stated above, as was pointed out in Francis (now withdrawn) and Liskowitz, fly ash itself has a particle size distribution in the range of about 1 to 100 microns. Massey simply uses fly ash which typically and conventionally ranges from about 1 to 100 microns which is in the applicants' claimed ranges for small, large, and coarse (optional) fraction fly ash portions. This overlaps applicants' claimed invention. Applicants have not shown criticality by their specific set amounts of the already overlapping particle size ranges for fly ash of the prior art.

Prior Art Cited of Interest:

Galer (US Patent No. 4,450,022) is cited of interest and could have been used in a rejection of applicants' claims above though the pending prior art does sufficiently teach applicants' claims. Galer teaches a method of making a cement board by coating a sheet with hydraulic cement and fly ash (see col.6, lines 27-54). Fly ash after its manufacture as a waste material typically has a particle size of about 1-100 microns and thus overlaps applicants' claimed ranges for their own large and small fly ash sizes.


Kawai (US Patent No. 5,863,477) teaches a coating a board with fly ash and cement material as well. Again, the typical particle size for fly ash is about 1-100 microns and overlaps applicants' own fly ash particle size ranges.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Paul Marcantoni  
Primary Examiner  
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